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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,820	02/25/2005	Kai Fabian	MERCK-2979	9173
23599	7590	12/29/2006	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			YOUNG, SHAWQUIA	
		ART UNIT		PAPER NUMBER
				1626
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	12/29/2006	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/525,820	FABIAN ET AL.	
	Examiner Shawquia Young	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 September 2006 and 03 October 2006.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,12,13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,12,13 and 15-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date October 3, 2006.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

Claims 1, 12, 13, 15, 16, and 17 are currently pending in the instant application.

As stated in the previous Office Action, claims 2-11 are withdrawn from consideration as being non-elected subject matter. Applicants cancelled claim 14 in an amendment filed on October 3, 2006.

### **I. Priority**

The instant application is a 371 of PCT/EP03/08514, filed on August 1, 2003, which claims benefit of Foreign Application GERMANY 102 40 026.1, filed on August 27, 2002.

### **II. Information Disclosure Statement**

The information disclosure statement (IDS) submitted on October 3, 2006 has been considered by the examiner. See Applicant's copies of the 1449.4

### **III. Response to Amendment and Arguments**

Applicants amendments to the claims and remarks filed on September 14, 2006 and October 3, 2006 have been entered in the application and considered.

Applicants maintain their previous traversal of the restriction requirement and the traversal is on the ground (s) that: a full restriction, rather than merely an election pursuant to Markush practice, was intended. Applicants further state that if the election of groups is being treated as under Markush practice, wherein additional species will be

searched if the elected species is found allowable, then applicants withdraw their traversal.

The Examiner has stated in the previous Office Action (pages 5-6) that if the elected species is free of the art then the search of the Markush-type claim will be extended.

Applicants' amendments and arguments have overcome the following rejections:

The 35 USC 103(a) rejection of claims 1, 12 and 13 as being obvious over the *Ohkuma, et al.* and *Deeter, et al.* references.

#### IV. Rejection(s)

##### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. § 103(a) that forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

*Graham v. John Deere Co.* set forth the factual inquiries necessary to determine obviousness under 35 U.S.C. §103(a). See *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Specifically, the analysis must employ the following factual inquiries:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 12, 13, and 15-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Michel* (EP 02015229.4). Applicants claim monoalkylaminoketones of the formula I defined in claim 1.

**The Scope and Content of the Prior Art (MPEP §2141.01)**

The reference, *Michel*, teaches N-monoalkyl  $\beta$ -amino ketones and the process of preparing these ketones.

**The Difference Between the Prior Art and the Claims (MPEP §2141.02)**

The difference between the prior art, *Michel*, and the instant invention is that the applicants are claiming monoalkylaminoketone compounds, wherein R<sup>1</sup> is defined as a saturated, unsaturated or aromatic carbocyclic or heterocyclic radical opposed to R<sup>1</sup> being defined as furyl, benzofuranyl, isobenzofuranyl, thieryl and benzo [b] thieryl. Further, the instant application claims the species, wherein R<sup>1</sup> is thieryl and R<sup>2</sup> is methyl opposed to the reference defining R<sup>1</sup> as thieryl and R<sup>2</sup> as methyl, ethyl, sec-butyl or tert-butyl and claims species, wherein R<sup>1</sup> is furyl, R<sup>2</sup> is methyl and R<sup>1</sup> is naphthyl, R<sup>2</sup> is methyl (See Claims 9-12, pages 21-22).

**Prima Facie Obviousness-The Rational and Motivation (MPEP §2142-2413)**

The various species of the genus compounds claimed in the instant invention

have already been taught in the reference, *Michel*. Since the reference has an earlier filing date than the instant application, the reference is considered to be prior art. For example, the reference, as mentioned above, claims a compound wherein R<sup>1</sup> is thiaryl and R<sup>2</sup> is methyl, ethyl, sec-butyl or tert-butyl. Therefore, it would have been prima facie obvious to one having ordinary skill in the art at the time of the invention was made to prepare a species wherein R<sup>1</sup> is thiaryl and R<sup>2</sup> is methyl. Further the reference claims a species wherein R<sup>1</sup> is napthyl and R<sup>2</sup> is methyl. So it would also have been prima facie obvious to one having ordinary skill in the art to prepare a genus that contains various compounds wherein R<sup>1</sup> is a carbocyclic and R<sup>2</sup> is an alkyl having 1-20 C atoms.

#### **V. Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 8:00 AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M<sup>c</sup>Kane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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